

REMARKS

Applicants hereby traverse the outstanding rejections, and request reconsideration and withdrawal in light of the amendments and remarks contained herein. New claims 42-49 have been provided for consideration. Claims 21-49 are pending in this application.

Rejection under 35 U.S.C. § 103

Claims 21-31 and 33-41 are rejected under 35 U.S.C. § 102(b) as being anticipated by O'Neil ('440). Applicant believes that the Examiner intended to define this rejection as an obvious-type rejection and not anticipation-type rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the either the first criteria or the third criteria.

Lack of Claimed Limitations

The Office Action admits that O'Neil does not teach having the information source be any user of the Internet. The Office Action points out that any Internet user may sign up for the community based on established rules and regulations. However, this modification as presented, does not teach or suggest all limitations of the claimed invention.

Claim 21 defines obtaining the personal information of the owner by an information source, wherein the information source may be any user of the Internet.

Claim 34 defines a receive module that receives a plurality of personal information of the plurality of the owners from at least one information source, wherein the at least one information source may be any user of the Internet.

O'Neil, as modified, does not disclose at least these limitations. As stated in our previous response, O'Neil discloses a closed system, which limits participation only to members of the trusted communities. Applicant has reviewed the portions of the O'Neil

reference cited in support for the Examiner's position, namely column 4, lines 25-40 and column 2, lines 22-25, and Applicant cannot locate a source for "any Internet user may sign up for the community based on established rules and regulations." Nonetheless, the enrolled user is not any user of the Internet, but rather is a member of the community. Thus, O'Neil, as modified, does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 21 and 34 are patentable over the 35 U.S.C. § 102 rejection of record.

Claims 22-31, 33, and 35-41 depend directly from base claims 21 and 34, respectively, and thus inherit all limitations of their respective base claims. Each of claims 22-31, 33, and 35-41 sets forth features and limitations not recited by O'Neil as modified. Thus, the Applicants respectfully assert that for the above reasons claims 22-31, 33, and 35-41 are patentable over the 35 U.S.C. § 103 rejection of record.

Lack of Motivation

The Office Action admits that O'Neil does not teach having the information source be any user of the Internet. The Office Action asserts that O'Neil may be modified to remove security precautions and allow any user of the Internet to have access. The motivation for making the combination was presented as follows:

"It would have obvious ... to simply allow anyone on the Internet to use the system (website) disclosed [sic] by O'Neil, as it would simply be a matter of removing security precautions (registration) – for the purpose of reduction system set-up and operational maintenance costs."

It is well settled that it is impermissible to modify a reference where the proposed modification would change the principle of operation of the reference, see M.P.E.P. § 2143.01. The modification proposed by the Examiner contravenes the decrees of the M.P.E.P. O'Neil teaches the use of only having registered users access the system, see the entire patent, e.g. see the Abstract. Furthermore, see the text beginning at column 2, line 10 regarding the discussion of the formation of trusted communities. See also the text beginning at column 7, line 53 describing the process of joining the trusted community. Consequently, it is a principle operation of the reference to have only members of the community participate in the transactions. Thus, the proposed modification would change the basic principle under

which the system of O'Neil is designed to operate. The M.P.E.P. clearly states that such a modification substitution is impermissible, see M.P.E.P. § 2143.01. Therefore, the provided motivation is insufficient to perform the stated modification to O'Neil.

Moreover, a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention, M.P.E.P. § 2141.02. In the instant case, O'Neil teaches away from having any user of the Internet access the system. The background section of O'Neil discusses the problems with such an arrangement, e.g. see column 1, line 28 (no assurance that all this information is accurate or reliable), column 1, line 29 (the source is not even ascertainable), column 1, line 31 (anything sent via the Internet is subject to interception and misuse). These teachings in the background section would lead one of ordinary skill in the art not to remove the security precautions (registration) from the system of O'Neil. Therefore, the provided motivation is insufficient to perform the stated modification to O'Neil.

No valid suggestion has been made as to why a modification of O'Neil is desirable. Therefore, the rejection of claims 21-31 and 33-41 should be withdrawn.

Rejection under 35 U.S.C. § 103

Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Neil ('440).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first and second criteria, Applicants assert that the rejection does not satisfy the third criteria.

The Office Action admits that O'Neil does not teach enabling the requestor to decline receipt of the personal information based upon a cost of the personal information. The Office Action attempts to cure this deficiency by introducing common knowledge, which the Office

Action alleges to teach having such an element. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Base claim 21 is defined as described above. O'Neil does not disclose these limitations, as discussed above. The modification of O'Neil with common knowledge is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention.

Claim 32 depends directly from base claim 21, and thus inherits all limitations of claim 21. Claim 32 sets forth features and limitations not recited by O'Neil as modified in the rejection. Thus, the Applicants respectfully assert that for the above reasons claim 32 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Conclusion

New claims 42-49 have been provided for the consideration of the Examiner. New claims 42-49 set forth features and limitations not recited by the prior art of record. Thus, the Applicants respectfully assert that for the above reasons new claims 42-49 are patentable over the rejections of record.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Application No.: 09/539,558

Docket No.: 10992073-3


The fees for the Request for Continuing Examination and claims are figured on the Fee Transmittal sheet. At any time during the pendency of this application, please charge any additional fees required or credit any overpayment to Deposit Account No. 08-2025, under Order No. 10992073-3 from which the undersigned is authorized to draw.

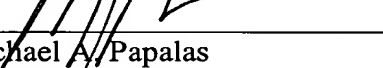
Dated: February 24, 2004

Respectfully submitted,

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256036885US, in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: February 24, 2004

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